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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/751,309 | 12/31/2003 | Nagesh K. Vodrahalli | ITS.0008US (P17998) | 8796 |

21906 7590 04/25/2006

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| EXAMINER | |
|---|---|
| STAHL, MICHAEL J | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2874 | |

DATE MAILED: 04/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| **Advisory Action Before the Filing of an Appeal Brief** | **Application No.** 10/751,309 | **Applicant(s)** VODRAHALLI ET AL. | |
|---|---|---|---|
| | **Examiner** Mike Stahl | **Art Unit** 2874 | |

*--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

THE REPLY FILED 12 April 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

Rodney Bovernick
Supervisory Patent Examiner
Technology Center 2800

MJS 4/18/2006
Mike Stahl
Art Unit 2874
571-272-2360

Continuation of 11. does NOT place the application in condition for allowance because: Arguments regarding Fan are not persuasive. The limitation of "optical signal" has been interpreted broadly. Given that Fan involves a camera, which generally creates a data representation of a scene, it is not believed unreasonable to assert that Fan indeed processes an optical signal. There are no recitations in the claims that limit the optical signal to any particular kind, other than "multiplexed", which merely suggests that multiple wavelengths are present (which they are in Fan). The comment that Fan was not relied on before is assumed to mean that Fan was not relied on for rejecting claim 1 before, since Fan was in fact previously relied on for rejecting other claims (11/2/2005 action). The use of Fan against claim 1 in the final rejection and not in the earlier action was due to the substantial broadening of claim 1 by the intervening 1/9/2006 amendment. The observation that "similar claims were previously indicated to be allowable when Fan was cited" is noted, but alleged similarity of claims does not guarantee allowability. For example, original claim 5 was indicated as containing allowable subject matter in the 11/2/2005 action. Originial claim 5 depended from and included all the limitations of original claims 1 and 4. Claim 1 of the 1/9/2006 amendment is vastly broader than original claim 5 and its allowability must be independently evaluated.

Arguments regarding Takagi are also not persuasive. The use of a single reference, in combination with knowledge generally available to one of ordinary skill in an art, to make a 103 rejection is permissible. There is no statutory requirement to involve two or more references. The argument that something cannot be known in the art because it is not in the applied reference is not persuasive. No single reference can be reasonably expected to teach all knowledge in an art, and if every rejection had to be based on explicit teachings in a single reference then 35 U.S.C. 103 would not be necessary. The remarks state that "to the extent that this art is intended to be relied upon, a reference should be cited". Such a reference was indeed cited (US 6188816, 11/2/2005 action, p. 6). The statement that "nothing anywhere in the prior art suggests" the rejection's rationale to combine is not persuasive - see e.g. the US 6188816 reference.